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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,636

02/04/2005

Nobuhiko Noto

136072

5874

25944

7590

02/17/2009

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

BOOKER, VICKI B

ART UNIT

PAPER NUMBER

2813

MAIL DATE

DELIVERY MODE

02/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/523,636	Applicant(s) NOTO ET AL.	
	Examiner VICKI B. BOOKER	Art Unit 2813	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: NONE.
 Claim(s) objected to: NONE.
 Claim(s) rejected: 1, 2, 4 - 7, 9 - 14, 17, 23, 25, 29, 31, 33, 34, 36, and 37.
 Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/W. David Coleman/
Primary Examiner, Art Unit 2823

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1, 2, 4 - 7, 9 - 14, 17, 23, 25, 29, 31, 33, 34, 36, and 37 are rejected under 35 USC 103(a) as noted in the final office action. Examiner notes Applicant has filed no new or amended claims with this Request for Reconsideration.

Regarding Claim 1 and Claim 12, Applicant argues that Toshihiro's heat treatment time would not result in the Indium concentration having a Cb/Ca ratio of 0.8 or below as claimed. Applicant also argues Lakhani does not disclose preventing a decrease of light emitting strength caused by lattice mis-matching of the contact layer and the light emitting layer. These arguments are not found to be persuasive, as Applicant's arguments against the references individually cannot show nonobviousness where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Claims 6, 23, and 37, Applicant argues it would not have been obvious to one of ordinary skill in the art to modify the method of Hsieh with the teachings of Toshihiro and Lakhani to result in the claimed contact-layer having a thickness range of 0.001 micron or more and 0.002 micron or less, because utilizing the contact layer for its contact improvement deprives light emission and would defeat the purpose of the contact layer, and further argues that it would be meaningless to use the oxide transparent electrode layer with a contact layer that is used for contact improvement.

These arguments are not found to be persuasive. Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the instant case, Examiner notes Claim 6 is dependent on Claim 1; Claim 23 is dependent on Claim 2; and Claim 37 is dependent on Claim 13. Claim 6 and Claim 23 are unpatentable over Hsieh et al. in view of Toshihiro et al. and further in view of Lakhani for the reasons set forth, respectively, in the final office action.

Furthermore, since Claim 37 is unpatentable over Hsieh et al. in view of Toshihiro et al., further in view of Lakhani, and still further in view of Bass et al. for the reasons set forth in the final office action, Applicant's argument with respect to Claim 37 appears to be a piecemeal analysis, which is not found to be persuasive since one cannot show nonobviousness by attacking the combination of Hsieh et al. in view of Toshihiro et al., further in view of Lakhani individually where the rejection is based on a different combination of references (i.e. Hsieh et al. in view of Toshihiro et al., further in view of Lakhani, and still further in view of Bass et al.) See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Claims 9 - 11, 17, 29, 31, 33, 34, and 36, Applicant argues these claims incorporate the features of independent Claim 1 and independent Claim 12, which are allowable over the prior art cited based on Applicant's arguments; and further argues Saeki and Bass fail to overcome the deficiencies of the other applied references. This is not found to be persuasive, since Claim 1 and Claim 12 are unpatentable under 35 USC 103(a) as noted in the final office action, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).